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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,174	02/16/2001	Joseph P. Steiner	22903XA-T	1443

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EXAMINER

COOK, REBECCA

ART UNIT

PAPER NUMBER

1614

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/784,174
Filing Date: February 16, 2001
Appellant(s): STEINER ET AL.

Sean Passino
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 15, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 17-32 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Rejection under the judicially created doctrine of obviousness-type double patenting.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5, 6, 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-32 of copending Application No. 09/879,888. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims read on the

claims of '888 when J and K in the instant claims form a heterocyclic ring which is substituted with O, S, SO or SO₂.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The instant claims 5, 6 and 8 are to a pharmaceutical composition comprising a nitrogen-containing compound of Formula I, II and IV respectively in which J and K may be taken together to form a heterocyclic ring which is substituted with a second heterocyclic atom. The claims further recite a second hair revitalizing agent and a pharmaceutically acceptable compound.

Claims 1-31 of '888 are to pharmaceutical compositions comprising a nitrogen-containing compound having two or more heteroatoms. Claim 32 is to a heterocyclic compound having two or more heteroatoms when V is N. All of the claims further recite a second hair revitalizing agent and a pharmaceutically acceptable carrier.

The instant claims read on claims 1-31 of '888 when J and K in claims 5, 6 and 8 form a heterocyclic ring and the heterocyclic ring in the claims of each application are substituted with the same second heterocyclic atom.

In the absence of a terminal disclaimer to the instant application there would be an extension of monopoly on the first issuing application.

(11) Response to Argument

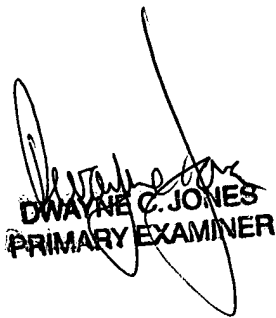
Appellants argue that overlap cannot establish a case of nonstatutory obviousness-type double patenting. This is not persuasive for the reasons given above. The compositions of both '174 and '888 include heterocyclic compounds that are the

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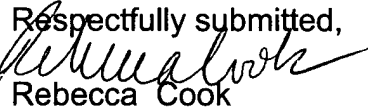
same when the compounds of '174 have heterocyclic rings and the heterocyclic rings of both '174 and '888 are each substituted with the same second heterocyclic atom.

Furthermore, in the absence of a terminal disclaimer to the instant application there would be an extension of monopoly on the first issuing application.

For the above reasons, it is believed that the rejections should be sustained.



DWAYNE C. JONES
PRIMARY EXAMINER

Respectfully submitted,


Rebecca Cook
Primary Examiner
Art Unit 1614

RC
December 28, 2002

Conferees


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